



D-1077+18

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)	
Jay Paul Drummond, et al.)	
)	
Serial No.: 09/639,310)	Art Unit 3624
)	
Confirmation No.: 9530)	
)	
Filed: August 14, 2000)	Patent Examiner
)	Debra F. Charles
)	
Title: Automated Banking Machine)	
Customer Profile Method)	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
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**SECOND SUPPLEMENTAL BRIEF OF APPELLANTS
PURSUANT TO 37 C.F.R. § 41.37**

Sir:

The Appellants hereby respectfully request reinstatement of their appeal. The Appellants hereby submit their 2nd Supplemental Appeal Brief pursuant to 37 C.F.R. § 41.37 concerning the above-referenced Application. This 3rd Appeal Brief is in response to the Office Action dated February 7, 2005.

(i)

REAL PARTY IN INTEREST

The Assignee of all right, title and interest to the above-referenced Application is Diebold, Incorporated, an Ohio corporation.

(ii) RELATED APPEALS AND INTERFERENCES

Other applications (09/193,564; 09/193,646; 09/193,647; 09/193,662; 09/193,787; 09/193,791) having been assigned appeal numbers claim priority to the parent application (09/077,337). It is believed that these other appeals do not pertain to the claimed subject matter. However, it is respectfully requested that the Board make its own determination regarding the pertinence of these other applications. The Board is also requested to check (update) the status of other applications claiming priority to the parent application with regard to appeal.

Appellants, Appellants' legal representative, and assignee believe that there are no additional related appeals or interferences pertaining to this matter.

(iii)

STATUS OF CLAIMS

Claims 1-28 are pending in the Application.

Claims rejected: 1-28

Claims allowed: none

Claims confirmed: none

Claims withdrawn: none

Claim objected to: none

Claims canceled: none

Appellants appeal the rejections of claims none, inclusive. These rejections were the only rejections present in the Office Action (“Action”) dated February 7, 2005, which was made final.

(iv)

STATUS OF AMENDMENTS

The Action dated February 7, 2005 followed a reopening of prosecution (which followed submission of the 1st and 2nd Appeal Briefs). Appellants respectfully request reinstatement of their appeal.

The Action dated February 7, 2005 was made final. No amendments to the claims were requested to be admitted after the final rejection.

Additional Comments

The making final the new grounds of rejection to unamended claims 9-12 has not gone unnoticed. This premature final rejection is merely reflective of the impropriety of all the rejections in the Action.

Appellants desire to proceed with their appeal to prevent even further unnecessary prosecution delay caused by the Office. Furthermore, as shown in more detail herein, Appellants' claims are allowable over the (latest) new grounds of rejection. Thus, Appellants respectfully request reinstatement of their appeal.

(v) SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of exemplary forms of the claimed invention:

With respect to independent claim 1

An exemplary form of the invention is directed to a method of operating an automated transaction machine (e.g., ATM 12; Figures 1-3). The method includes reading customer identification information from a card with a card reading device (e.g., 38; Figure 2; page 14, lines 20-22; page 85, lines 14-17). The method further includes accessing at least one customer profile value (e.g., 419, 421, 425, 426) from at least one data store (e.g., 266, 608, 610, 612; Figures 43 and 55), responsive to the customer identification information (e.g., page 107, lines 17-20; page 109, lines 14-15; page 95, lines 11-14; page 35, lines 6-16). The method additionally includes generating at least one web page responsive to the at least one customer profile value (e.g., page 106, line 21 to page 107, line 1; page 35, lines 6-12; page 36, lines 14-16). The method also includes displaying (e.g., 30) the at least one web page at the machine through operation of a browser (e.g., 76), wherein the at least one web page includes a plurality of selectable transaction options for performing transactions with the automated transaction machine (e.g., page 106, line 21 to page 107, line 1; page 35, lines 18-21; page 37, lines 3-16). Also note page 25, line 11 to page 37, line 16, and pages 106-109.

With respect to independent claim 9

Another exemplary form of the invention is directed to a method. Support in the disclosure for similar claim language has previously been provided. The method includes reading an account number from a card with a card reading device (e.g., 38; Figure 2; page 14, lines 20-22; page 85, lines 14-17) of an automated transaction machine (e.g., ATM 12; Figures 1-3). The method further includes accessing a plurality of customer profile values that correspond to the account number (e.g., page 107, lines 17-20; page 109, lines 14-15; page 95, lines 11-14; page 35, lines 6-16). The method additionally includes displaying (e.g., 30) a web page in a browser (e.g., 76) with the automated transaction machine (e.g., 12), wherein the web page includes a plurality of selectable options for performing a transaction with the automated transaction machine (e.g., page 106, line 21 to page 107, line 1; page 35, lines 18-21; page 37, lines 3-16), wherein at least one of the selectable options is produced responsive to at least one of the accessed customer profile values (e.g., page 106, line 21 to page 107, line 1; page 35, lines 6-12; page 36, lines 14-16). The method also includes receiving an input that corresponds to a selected one of the selectable options with an input device (e.g., page 106, line 21 to page 107, line 3; page 37, lines 1-16). The method moreover includes performing the transaction with the automated transaction machine responsive to the selected one of the selectable options (e.g., page 106, line 21 to page 107, line 3).

With respect to independent claim 13

Another exemplary form of the invention is directed to a method. Support in the disclosure for similar claim language has previously been provided. The method includes receiving at least one customer identification value (e.g., page 107, lines 17-20) with an automated transaction machine (e.g., ATM 12; Figures 1-3). The method further includes accessing a customer profile from a data store (e.g., 266, 608, 610, 612; Figures 43 and 55), wherein the customer profile corresponds to the customer identification value (e.g., page 107, lines 17-20; page 109, lines 14-15; page 95, lines 11-14; page 35, lines 6-16), wherein the customer profile includes a customer type value (e.g., 419) that differentiates between classes of customers with regard to operations available with the automated transaction machine (e.g., page 106, lines 5-8). The method additionally includes displaying (e.g., 30) a web page in a browser (e.g., 76) of the automated transaction machine (e.g., 12), wherein the web page is loaded responsive to the customer type value (e.g., page 106, line 21 to page 107, line 1).

With respect to independent claim 21

Another exemplary form of the invention is directed to a method. Support in the disclosure for similar claim language has previously been provided. The method includes receiving customer identity information at an ATM (e.g., 12; Figure 2; page 14, lines 20-22; page 85, lines 14-17), wherein the ATM (12) includes a cash dispenser (42; Figure 2) operative to dispense cash. The method further includes accessing a customer profile responsive to the customer identity information (e.g., page 107, lines 17-20; page 109, lines 14-15; page 95, lines 11-14; page 35, lines 6-16). The method also includes retrieving marketing information from the

customer profile (e.g., page 108, lines 1-4). The method additionally includes selecting a targeted advertisement responsive to the marketing information (e.g., page 108, lines 1-4; page 30, lines 1-3; page 38, lines 19-22). The method further includes displaying (e.g., 30) a web page in a browser (e.g., 76) of the ATM (12), wherein the web page includes the targeted advertisement (e.g., page 108, lines 1-4).

With respect to independent claim 25

Another exemplary form of the invention is directed to a method. Support in the disclosure for similar claim language has previously been provided. The method includes receiving customer identification information with an ATM (e.g., 12; Figure 2; page 14, lines 20-22; page 85, lines 14-17), wherein the ATM (12) includes at least one banking transaction function device (e.g., 36), wherein the at least one banking transaction function device includes a currency dispenser (42; Figure 2) operative to dispense currency. The method additionally includes displaying (e.g., 30) at least one web page at the ATM (12) through operation of at least one browser (e.g., 76), wherein the at least one web page respectively corresponds to the received customer identification information (e.g., page 107, lines 17-22; page 106, line 21 to page 107, line 1), wherein the at least one web page includes a plurality of banking transaction selections associated with performing banking transactions with the ATM (e.g., page 106, line 21 to page 107, line 1; page 35, lines 18-21; page 37, lines 3-16), and wherein at least one of the selections includes a currency withdrawal request (e.g., page 107, lines 13-16; page 37, lines 3-9).

(vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The questions presented in this appeal are:

- 1). Whether claims 1-3, 9-10, 13, 21, and 25-28 are unpatentable pursuant to 35 U.S.C. § 103(a) over Semple in view of Dasan, Lawlor, and Simmons.
That is, Semple (U.S. 6,085,177), Dasan (U.S. 5,761,662), Lawlor, et al. (US 5,220,501) ("Lawlor"), and Simmons (US 5,974,451).
- 2). Whether claims 5, 8, 12, 20, and 24 are unpatentable pursuant to 35 U.S.C. § 103(a) over Semple in view of Dasan, Lawlor, and Simmons and further in view of Deaton and Jheeta.
That is, Deaton, et al. (US 5,642,485) ("Deaton") and Jheeta (US 5,619,558).
- 3). Whether claim 22 is unpatentable pursuant to 35 U.S.C. § 103(a) over Semple in view of Dasan, Lawlor, and Simmons and further in view of Jheeta.
- 4). Whether claim 4 is unpatentable pursuant to 35 U.S.C. § 103(a) over Semple in view of Dasan, Lawlor, and Simmons and further in view of Akiyama, et al. (US 5,539,825) ("Akiyama").

- 5). Whether claims 6-7, 11, 17, and 23 are unpatentable pursuant to 35 U.S.C. § 103(a) over Semple in view of Dasan, Lawlor, and Simmons and further in view of Patterson, et al. (US 5,915,246) ("Patterson").
- 6). Whether claims 14-15 and 18 are unpatentable pursuant to 35 U.S.C. § 103(a) over Semple in view of Dasan, Lawlor, and Simmons and further in view of Clausing (US 4,091,448).
- 7). Whether claim 16 is unpatentable pursuant to 35 U.S.C. § 103(a) over Semple in view of Dasan, Lawlor, Simmons, and Clausing and further in view of Patterson.
- 8). Whether claim 19 is unpatentable pursuant to 35 U.S.C. § 103(a) over Semple in view of Dasan, Lawlor, Simmons, and Clausing and further in view of Martin, Jr. et al. (US 6,304,860) ("Martin").

(vii)

ARGUMENT

The 35 U.S.C. § 103 (a) Rejections

The Applicable Legal Standards

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142 (Eighth Edition, August 2001; Rev. 2, May 2004).

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

A determination of patentability must be based on evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

The 35 U.S.C. § 103(a) rejections are legally improper

Appellants traverse the rejections on the grounds that Appellants' claims recite features and relationships which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. Nor do the references teach or suggest the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed Cir. 1990). The features and relationships recited in Appellants' claims patentably distinguish over the applied references.

The only suggestion for the recited features and relationships is found in Appellants' own novel disclosure. It follows that the rejections are based solely on hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

The Office has not established a *prima facie* showing of obviousness. Additionally, it would not have been obvious to one having ordinary skill in the art to have combined the references as alleged to have produced the recited invention. Thus, Appellants respectfully submit the rejections are improper and should be withdrawn.

**The Claims Are Not Obvious Over
Semple in view of Dasan, Lawlor, and Simmons**

Claims 1-3, 9-10, 13, 21, and 25-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Semple in view of Dasan, Lawlor, and Simmons.

The Action (at page 4, first paragraph) admits that Semple does not teach or suggest "the features of customer identification and, accessing at least one customer profile value from at least one data store, accessing a customer profile responsive to the customer identity information, wherein the customer profile corresponds to the customer type value, wherein a customer type value differentiates between classes of customers; responsive to the customer identification information, and displaying the at least one web page at the machine through operation of a browser."

The Action relies on Dasan for allegedly teaching "a user profile displaying on a web page whereby the user profile describes the customer preferences and identifies the type of customer via the client computer which provides the identification of a user-defined profile."

The Action (at page 4, last paragraph) admits that Semple and Dasan do not teach or suggest "retrieving marketing information from the customer profile; selecting a targeted advertisement responsive to the marketing information."

The Action relies on Lawlor for allegedly teaching "marketing information reflecting a customer profile built into the system."

The Action (at page 5, last paragraph) admits that Semple, Dasan, and Lawlor do not teach or suggest "the web page includes the targeted advertisement."

The Action relies on Simmons for allegedly teaching "targeted advertisements sent to the customer via a network web-based system."

The Appellants respectfully traverse the rejections. The Examiner has not explicitly read the claimed invention on the applied prior art. The Action fails to provide a claim by claim analysis of how the applied prior art teaches or suggests the claimed invention. Thus, how the Examiner reached the conclusions is not of record.

A proper *Graham v. John Deere* analysis has not been conducted

The Action fails to ascertain the differences between the applied prior art and the claims in issue. *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). The Action is silent as to the "differences" between the combination of Semple and Dasan and *all* the claims at issue. That is, the Action fails to point out what the references (Semple/Dasan) do *not* teach with regard to all the claims. For example, what features does the Office rely on in Lawlor and Simmons that are absent from Semple/Dasan with regard to claim 1? The indicated reliance upon Lawlor for "marketing information" and Simmons for "targeted advertisements" is not pertinent to claim 1. Actually, "marketing information" and "targeted advertisement" only appear in claims 21-24. Therefore, as best understood (in the absence of any contrary evidence), Lawlor and Simmons only apply to claims 21-24. Appellants have already overcome rejections to claims 1-3, 9-10, 13,

and 21 that relied only on "Semple in view of Dasan" in the Response filed November 24, 2004 (herein incorporated by reference).

Because the Action has not properly conducted a *Graham v. John Deere* analysis, and therefore has not met the required criteria for a *prima facie* case of obviousness, it follows that no *prima facie* case of obviousness has been established. That is, the Action procedurally fails to establish a *prima facie* case of obviousness.

The Appellants respectfully decline to speculate on any other intended (and not of record) application of Lawlor and Simmons. Appellants are not required to prove patentability. Contrarily, it is the Office which must establish a *prima facie* case of obviousness *under the law*. Absent a *prima facie* showing of obviousness, the Office is legally required to issue a patent. For these reasons, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejections should be withdrawn.

Appellants further respectfully request that, in view of this 3rd Appeal Brief, the Board not grant the Examiner another try to meet her burden via a remand. If a *prima facie* case of unpatentability was not already established by the Office at the time of appeal, then the rejections should be reversed. Following reversal, when jurisdiction is returned to the examining group, the Examiner still has ample opportunity to take further action. Even so, Appellants acknowledge that it is the sole discretion of the Board to determine the best course of action.

Appellants below provide a response to the claim rejections (as best understood) in spite of the improper analysis. However, Appellants reserve all rights to amend their arguments, including the filing of another Supplemental Appeal Brief, because of the improper analysis.

Claim 1

The Appeal Brief dated May 12, 2004, herein incorporated by reference, provides many reasons why Semple does not teach or suggest the recited invention.

The Action (at page 4, first paragraph) admits that Semple does not teach or suggest the steps of "accessing at least one customer profile value from at least one data store, accessing a customer profile responsive to the customer identity information" (step b), and "displaying the at least one web page at the machine through operation of a browser" (step d). Appellants respectfully submit that Semple lacks more of the recited steps (i.e., steps a and c) than the Action admits. As shown in more detail below, Semple does not teach or suggest *any* of the recited steps.

Semple does not teach or suggest recited step (a). Step (a) recites "reading customer identification information from a card with a card reading device in operative connection with an automated transaction machine." The only "card" that Semple mentions is a communication card (218). Where does Semple teach or suggest the communication card (218) having "customer identification information"?

Nor does Semple teach or suggest a card reader, as alleged. The alleged card reader in Semple is actually a keyboard (228). Where does Semple teach or suggest the keyboard (228) comprising a card reader?

The Action further alleges that Semple has a "normal user interface" and "normal functions" are performed, including reading data from an inserted card. The Appellants respectfully disagree. The Examiner reads Semple out of context and attributes features thereto which are not disclosed. Semple has a "keyboard 228 that provides a normal user interface to

both ATM transactions and the access to the Internet 214" (col. 4, lines 47-49). Semple likewise indicates that "The processor 224 performs normal functions of a prior-art ATM system; and additionally performs communication functions to facilitate communication with the Internet 214" (col. 4, lines 29-32). The Action ignores Semple's indication that a "user interface" means a key pad, a touch pad, a computer terminal, a keyboard, and can further include a voice recognition system (col. 3, lines 28-30). Again, where does Semple teach or suggest "reading customer identification information from a *card* with a *card reading device*"? Contrarily, Semple appears to teach away from having (or needing) a card reader by the reference to "walk up" capabilities (col. 3, lines 33-38) and a "voice recognition" system (242) (col. 3, lines 29-33; col.5, lines 3-10). It follows that Semple does not teach or suggest recited step (a).

Semple also does not teach or suggest recited step (c). Step (c) recites "generating at least one web page responsive to the at least one customer profile value." If Semple's web page access is responsive to pressing the Web access key (230) (col. 4, lines 49-51), then how can it be responsive to a customer profile value? Also, if Semple does not teach or suggest step (b), which the Action admits, then Semple cannot teach or suggest step (c). Accordingly, the Action (on page 3) apparently alleges that Semple teaches only a portion of step (c), namely "generating at least one web page." It follows that Semple does not teach or suggest recited step (c).

Returning to step (b), the Action admits that Semple does not teach or suggest "accessing at least one customer profile value from at least one data store, accessing a customer profile responsive to the customer identity information." That is, the Action admits that Semple does not teach or suggest the recited customer profile, data store, or accessing a customer profile

responsive to customer identification information (read from a card). The Action admits that Semple does not teach or suggest step (b).

Returning to step (d), step (d) refers back to *the* at least one web page of step (c). The Action admits that Semple does not teach or suggest "displaying the at least one web page at the machine through operation of a browser." That is, the Action admits that Semple does not teach or suggest displaying (at an automated transaction machine) a web page that was generated in response to a customer profile value that was accessed from a data store in response to customer identification information read from a card with a card reading device. The Action admits that Semple does not teach or suggest step (d).

The Appellants respectfully submit that Semple further does not teach or suggest, the part of step (d) that recites "the at least one web page includes a plurality of selectable transaction options for performing transactions *with* the automated transaction machine." The Action (on page 3, last paragraph) relies on Semple at col. 3, lines 5-25 for the teaching. Yet the Action (on page 14, first paragraph) *admits* that Semple does not teach or suggest displaying a web page "including a plurality of selectable transaction options for performing transactions with the automated transaction machine."

Furthermore, the relied upon section (col. 3, lines 5-25) of Semple appears to only indicate that the same screen (234) is used to (separately) display both web pages and ATM transactional information. In like manner Semple's keyboard (228) is commonly used for both ATM transactions and the Internet (col. 4, lines 47-49). Where does Semple teach or suggest a relationship between a web page and the performing of ATM transactions? By pressing Semple's Web access key (230) a user accesses the Internet (214). Thus, it appears that once a user presses

the Web access key (230) then the user would leave any ATM transaction environment and enter a separately maintained Internet environment. Where does Semple link the ATM transaction side to the Internet side? Where does Semple teach or suggest using a web page to select which ATM transaction is to be performed? As Semple appears to maintain ATM transactions separate from Internet usage, it would not have been obvious to have modified Semple in the manner alleged.

Appellants have shown (by either admitted or noted deficiencies) that the primary reference (Semple) does not teach or suggest *any* of the recited steps. Dasan cannot alleviate the deficiencies of Semple as it does not teach or suggest the recited features, relationships, and steps which are not found in Semple.

Dasan is non analogous art. Dasan is directed to creating a newspaper (col. 2, lines 41-42; col. 1, lines 13-15). One skilled in the art of ATM usage would recognize that it would not have been obvious (nor tolerated by other customers waiting in line) to modify Semple (if somehow even possible) to permit creating and reading a newspaper at Semple's ATM. Semple desires users to have the ability to quickly access geo-defined location information within a selected area of an ATM (e.g., col. 1, lines 16-19 and 50-53; col. 3, lines 35-40; col. 4, lines 60-67; col. 5, lines 10-16). The alleged modification to Semple would destroy the disclosed utility and advantage of Semple. An obviousness rejection cannot be based on a combination of features if making the combination would result in destroying the utility or advantage of the device shown in the prior art reference. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1598-99 (Fed. Cir. 1988).

Dasan (like Semple) does not teach or suggest step (a). Dasan does not teach or suggest reading customer identification information from a card with a card reading device. Dasan

doesn't even mention a card or a card reader. Additionally, the Action (on page 8) *admits* that "Semple et al., Dasan, Lawlor et al., Simmons . . . disclose(s) the claimed invention except customer identification." It follows that the relied upon Semple and Dasan, taken alone or in combination, do not teach or suggest step (a) of claim 1.

Dasan (like Semple) also does not teach or suggest step (b). Dasan's "profile" is limited to search (criteria) specifications (col. 5, lines 61-64) for creating a newspaper (col. 2, lines 41-42; col. 1, lines 13-15). The "profile" includes the types of newspaper stories/articles which are of interest to the user (col. 4, lines 46-50). Where does Dasan access a customer profile value (from a data store) responsive to customer identification information (read from a card with a card reading device) in an automated transaction machine environment?

Dasan (like Semple) also does not teach or suggest step (c). As Dasan does not teach or suggest steps (a) and (b), Dasan cannot teach or suggest generating a web page responsive to *the* customer profile value in the manner recited in step (c). Where does Dasan teach or suggest generating a web page in response to a customer profile value that was accessed from a data store in response to customer identification information read from a card with a card reading device?

Dasan (like Semple) also does not teach or suggest step (d). Step (d) refers back to *the* at least one web page of step (c). Where does Dasan teach or suggest displaying a web page to present selectable transactions to perform with an automated transaction machine? Nor does Dasan teach or suggest displaying (at an automated transaction machine) a web page that was generated in response to a customer profile value that was accessed from a data store in response to customer identification information read from a card with a card reading device.

Appellants have shown that the references (Semple in view of Dasan) do not link display of a web page to a customer's profile that was accessed from reading a card. Nor do the references teach or suggest accessing a customer's profile from customer identification read from a card, and using the customer's profile to display a web page having selections for using an automated transaction machine to perform transactions. Nor do the references link the web page display of automated transaction machine transaction options to reading customer identification from a card. It follows that the relied upon Semple and Dasan, taken alone or in combination, do not teach or suggest claim 1 (or any step in claim 1). For reasons previously discussed, as best understood, Lawlor and Simmons have not been applied by the Office against any of the steps of claim 1. It follows that the Office has not established a *prima facie* case of obviousness.

Furthermore, even if Lawlor and Simmons were somehow applied against claim 1 they still cannot alleviate the many admitted and noted deficiencies of Semple/Dasan as they also do not teach or suggest the recited features, relationships, and steps which are not found in Semple/Dasan. Lawlor is directed to dedicated telephone-based home banking (col. 7, lines 5-7) that does not require a card. Simmons is non analogous art.

The references of Lawlor and Simmons (like Semple and Dasan) do not link display of a web page to a customer's profile that was accessed from reading a card. Nor do the references teach or suggest accessing a customer's profile from customer identification read from a card, and using the customer's profile to display a web page to present selectable transactions to perform with an automated transaction machine. Nor do the references link the web page display of automated transaction machine transaction options to reading customer identification from a card. Furthermore, the Action (on page 14, first paragraph) *admits* that

Semple/Dasan/Lawlor/Simmons do not teach or suggest displaying a web page "including a plurality of selectable transaction options for performing transactions with the automated transaction machine." That is, the Action itself admits that all combined references still would not teach or suggest recited step (d).

It follows that the relied upon Semple, Dasan, Lawlor, Simmons references, taken alone or in combination, do not teach or suggest the recited method of claim 1. The Action's assertions are not based on any evidence in the record. *In re Zurko*, supra. *In re Lee*, supra.

The references do not teach or suggest the desirability of the combination. *In re Mills*, supra. The rejection is based on pure hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, supra. The rejection lacks the necessary evidence and rationale, and is based on knowledge gleaned only from Appellants' disclosure. There is no teaching, suggestion, or motivation for combining features of the references so as to produce the recited invention.

The Action is also silent with regard to reasonable specificity as to how Semple could be structurally modified with the alleged secondary teachings to perform the recited method. Applicants have been left to speculate as to how the many alleged features in the large number of secondary references could be implemented in the disclosed teaching of Semple. Accordingly, the Action procedurally fails to establish a *prima facie* case of obviousness. *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989).

The references do not teach or suggest the recited features, relationships, and steps. It would not have been obvious to one having ordinary skill in the art to have modified Semple as alleged to have produced the recited method. Even if it were somehow possible (which it isn't)

for the references to be combined as alleged, the resultant combination still would not have produced the recited method. Appellants respectfully submit that the Office has not established a *prima facie* showing of obviousness. Thus, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection should be withdrawn.

Claim 2

The references further do not teach or suggest modifying a customer profile value in a data store responsive to operator input to an automated transaction machine. Where do the references permit a customer of an automated transaction machine to modify that customer's profile? As previously discussed, in *Dasan* a "profile" is merely user-defined search criteria for finding newspaper stories/articles which are of interest to the user. Where does *Dasan* modify a customer profile value in response to a received input to an automated transaction machine? The Office has not established a *prima facie* showing of obviousness.

Claim 3

Claim 3 depends from claim 2/1. Nor do the references teach or suggest modifying a customer profile value in a data store having a remote database in response to operator input to an automated transaction machine. The Action relies on *Semple* at col. 3, lines 44-50. However, where does *Semple* modify a customer profile value in a data store having a remote database, especially when the Action admits (on page 6) that *Semple* does not modify a customer profile value? The Office has not established a *prima facie* showing of obviousness.

Claim 9

Appellants' remarks in support of the patentability of claim 1 are incorporated herein by reference. For reasons already discussed, the Office has not established a *prima facie* showing of

obviousness. The references, taken alone or in combination, do not teach or suggest reading an account number from a card with a card reading device of an automated transaction machine; accessing a *plurality* of customer profile *values* that correspond to *the* account number; displaying a web page having selectable options for performing a transaction with *the* automated transaction machine, where at least one of the selectable options is produced responsive to at least one of *the* accessed plural customer profile values; receiving an input corresponding to a selected one of *the* selectable options; and performing a transaction with *the* automated transaction machine based on *the* selected option.

The references, taken alone or in combination, do not link display of a web page to a customer's profile that was accessed from reading a card. Nor do the references teach or suggest accessing a customer's profile from an account number read from a card, and using the customer's profile to display a web page to present selectable transaction options to perform with an automated transaction machine. Nor do the references relate a web page display of automated transaction machine transaction options to reading an account number from a card with the automated transaction machine. Nor do the references teach or suggest performing, with an automated transaction machine, a transaction that was selected from a displayed web page. Again, the Office has not established a *prima facie* showing of obviousness.

Claim 10

Claim 10 depends from claim 9. The references further do not teach or suggest modifying an accessed customer profile value in a data store in response to receiving a selection for performing a transaction with an automated transaction machine. Where do the references permit modification to a customer profile responsive to a selected option input? As previously

discussed, in Dasan a "profile" is merely user-defined search criteria for finding newspaper stories/articles which are of interest to the user. Where does Dasan modify an accessed customer profile value in response to selecting a transaction option in a web page at an automated transaction machine? The Office has not established a *prima facie* showing of obviousness.

Claim 13

Appellants' remarks in support of the patentability of claim 1 are incorporated herein by reference. The Action (on page 4) admits that Semple does not teach or suggest steps (a), (b), and (c). However, the Action is silent as to where the secondary references teach or suggest the recited features, relationships, and steps.

For reasons already discussed, the references, taken alone or in combination, do not teach or suggest displaying a web page in an automated transaction machine responsive to a customer type value, where the customer type value differentiates between classes of customers with regard to operations available with the automated transaction machine, where a customer profile accessed from a data store includes the customer type value, and where the customer profile corresponds to a customer identification value received with the automated transaction machine.

Where do the references teach or suggest a customer profile that includes the customer type in terms of availability of automated transaction machine operations? Where do the references teach or suggest a customer profile that differentiates between classes of customers with regard to operations available with the (same) automated transaction machine? The references do not link a customer's identification at an automated transaction machine to the class of operations available to *that* customer with *that* automated transaction machine. The Office has not established a *prima facie* showing of obviousness.

Claim 21

Appellants' remarks in support of the patentability of claim 1 are incorporated herein by reference. For the many reasons already discussed, Semple and Dasan, taken alone or in combination, do not teach or suggest the recited method. The Action (on pages 4 and 5) admits that Semple/Dasan do not teach or suggest "retrieving marketing information; selecting a targeted advertisement responsive to the marketing information" nor that a "web page includes the targeted advertisement." As previously discussed, these are not the only features absent in Semple/Dasan.

Lawlor and Simmons cannot alleviate the admitted and noted deficiencies of Semple/Dasan as they also do not teach or suggest the recited features, relationships, and steps which are not found in Semple/Dasan. Lawlor is directed to dedicated telephone-based home banking (col. 7, lines 5-7). Lawlor does not teach or suggest accessing a customer profile responsive to customer identity information *received at an ATM*. Lawlor's home banking does not occur at an ATM. Some would argue that home banking is the antithesis of ATM banking. Even Lawlor teaches that a home banking terminal is "unlike an ATM" (col. 10, lines 30-32). Therefore, Lawlor teaches away from the recited invention.

It follows that Lawlor does not teach or suggest "retrieving marketing information" from a customer profile accessed in response to customer identity information received at an ATM. It further follows that Lawlor does not teach or suggest "selecting a targeted advertisement" responsive to the marketing information (which was retrieved from a customer profile that was accessed in response to customer identity information received at an ATM). Nor does Lawlor teach or suggest displaying a web page *in* a browser of an *ATM*, especially where the web page

includes the targeted advertisement (which was selected in response to marketing information that was retrieved from a customer profile which was accessed in response to receiving the customer's identity information at *the* ATM). Where does Lawlor even teach or suggest displaying a web page targeted advertisement at an ATM? Where does Lawlor teach or suggest a browser?

Simmons is non analogous art. Simmons (like Lawlor, Dasan, and Semple) does not teach or suggest displaying a web page targeted advertisement at an ATM. Where does Simmons even mention an ATM? Simmons does not teach or suggest displaying a web page *in* a browser of an *ATM*, especially where the web page includes a targeted advertisement (which was selected in response to marketing information that was retrieved from a customer profile which was accessed in response to receiving the customer's identity information at *the* ATM).

The references of Lawlor and Simmons (like Semple and Dasan) do not link display of a web page targeted advertisement at an ATM to a customer's profile that was accessed from customer identity information received at *the* ATM.

The references do not teach or suggest the recited features, relationships, and steps. The rejection is based on impermissible hindsight reconstruction of Appellants' claimed invention. Nor do the references teach or suggest the desirability of the combination. *In re Mills*, supra. The references are devoid of any teaching, suggestion, or motivation for combining features of thereof so as to produce the recited invention. It would not have been obvious to one having ordinary skill in the art to have modified Semple as alleged to have produced the recited method. Even if it were somehow possible (which it isn't) for the references to be combined as alleged,

the resultant combination still would not have produced the recited method. The Office has not established a *prima facie* showing of obviousness.

Claim 25

Appellants' remarks in support of the patentability of claims 1 and 21 are incorporated herein by reference. For reasons previously discussed (including the admissions by the Office), Semple and Dasan, taken alone or in combination, do not teach or suggest the recited method. Lawlor and Simmons cannot alleviate the admitted and noted deficiencies of Semple/Dasan as they also do not teach or suggest the recited features, relationships, and steps which are not found in Semple/Dasan.

As previously discussed, the references (Semple, Dasan, Lawlor, and Simmons) do not teach or suggest displaying a (at least one) web page at a currency dispensing ATM, where the web page respectively corresponds to customer identification information received at *the* ATM. Nor do the references teach or suggest displaying a (at least one) web page that includes a plurality of banking transaction selections associated with performing banking transactions *with the* ATM, especially where a selection includes a currency withdrawal request. Where do the references teach or suggest displaying at an ATM a (at least one) web page having a selection for requesting a currency withdrawal with *the* ATM? The references, taken alone or in combination, do not correspond the displaying at an ATM of a web page of banking transaction selections (with a currency withdrawal request being one of the selections) to customer identification information received at *the* ATM.

The references do not teach or suggest the recited features, relationships, and steps. Nor has the Office established a *prima facie* showing of obviousness. Even if it were somehow

possible (which it isn't) for the references to be combined as alleged, the combination still would not have produced the recited method.

Claim 26

The Action is silent regarding a prior art teaching or suggestion of the recited steps.

Claim 26 depends from claim 25. The references further do not teach or suggest selecting a banking transaction displayed in a web page at an ATM. Nor do the references teach or suggest accessing a markup language document from a data store, where the markup language document includes an instruction to cause operation of a banking transaction function device associated with the selection. The Office has not established a *prima facie* showing of obviousness.

Claim 27

The Action is silent regarding a prior art teaching or suggestion of the recited steps.

Claim 27 depends from claim 26/25. For reasons already discussed, the references further do not teach or suggest displaying banking transaction selections in a web page at an ATM, especially where the web page was generated in response to a customer profile that was accessed in response to customer identification information read at the ATM. The Office has not established a *prima facie* showing of obviousness.

Claim 28

Claim 28 depends from claim 27/26/25. The Action is silent regarding a prior art teaching or suggestion of the recited features. Where do the references teach or suggest operating an ATM currency dispenser in response to a dispense currency instruction in a markup document accessed via the Internet? The Office has not established a *prima facie* showing of obviousness.

**The Claims Are Not Obvious Over
Semple in view of Dasan, Lawlor, and Simmons
and further in view of Deaton and Jheeta**

Claims 5, 8, 12, 20, and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Semple in view of Dasan, Lawlor, and Simmons and further in view of Deaton and Jheeta.

Claim 5

The Action admits (on page 7) that Semple/Dasan/Lawlor/Simmons do not teach or suggest reading customer identification information from a smart card with a smart card reader device. The Action instead relies on Deaton. However, Deaton does not teach or suggest generating a web page responsive to a customer profile value accessed from a data store responsive to customer identification information read from a smart card. That is, Deaton does not link display of machine transaction options in a web page to customer identification read from a smart card. It follows that the alleged modification of Semple would not have resulted in use of a smart card reader device in the manner recited.

The Action (on page 8) further admits that "Semple et al., Dasan, Lawlor et al., Simmons and Deaton et al. disclose(s) the claimed invention except customer identification." However, the Action's reliance on Jheeta for allegedly teaching that "authorized transactions are conventionally stored in the customer database that contains customer identification" is moot, as claim 5 does not recite the relied upon features. The Action does not rely on Jheeta for the admittedly absent "customer identification" in Semple/Dasan/Lawlor/Simmons/Deaton. Nor does Jheeta teach or suggest the recited features. Hence, the Office has not established a *prima facie* showing of obviousness.

Claim 8

The references, taken alone or in combination, further do not teach or suggest computer readable media having computer readable instructions operative to cause at least one computer to carry out the recited steps of claim 1. The Action relies on Semple at col. 4, lines 45-60 as allegedly teaching the recited computer readable media. However, the relied upon section of Semple does not teach or suggest computer readable media that is operative to cause the recited method to be performed.

As previously discussed (e.g., claim 1), Semple does not teach or suggest the recited method of claim 1. Even the Action *admits* (on page 4; and via the obviousness type rejection) that Semple *alone* does not teach or suggest claim 1. Thus, the allegation that Semple discloses the computer readable instructions is without merit. The Office has not established a *prima facie* showing of obviousness.

Claim 12

The references, taken alone or in combination, further do not teach or suggest computer readable media having computer readable instructions operative to cause at least one computer to carry out the steps recited in claim 9. The Action relies on Semple at col. 4, lines 45-60 as allegedly teaching the recited computer readable media. However, the relied upon section of Semple does not teach or suggest computer readable media that is operative to cause the recited method to be performed.

As previously discussed (e.g., claim 9), Semple does not teach or suggest the recited method of claim 9. Even the Action *admits* (on page 4; and via the obviousness type rejection) that Semple *alone* does not teach or suggest claim 9. Thus, the allegation that Semple discloses

the computer readable instructions is without merit. The Office has not established a *prima facie* showing of obviousness.

Claim 20

The references, taken alone or in combination, further do not teach or suggest computer readable media having computer readable instructions operative to cause at least one computer to carry out the steps recited in claim 13. The Action relies on Semple at col. 4, lines 45-60 as allegedly teaching the recited computer readable media. However, the relied upon section of Semple does not teach or suggest computer readable media that is operative to cause the recited method to be performed.

As previously discussed (e.g., claim 13), Semple does not teach or suggest the recited method of claim 13. Even the Action *admits* (on page 4; and via the obviousness type rejection) that Semple *alone* does not teach or suggest claim 13. Thus, the allegation that Semple discloses the computer readable instructions is without merit. The Office has not established a *prima facie* showing of obviousness.

Claim 24

The references, taken alone or in combination, further do not teach or suggest computer readable media having computer readable instructions operative to cause at least one computer to carry out the steps recited in claim 21. The Action relies on Semple at col. 4, lines 45-60 as allegedly teaching the recited computer readable media. However, the relied upon section of Semple does not teach or suggest computer readable media that is operative to cause the recited method to be performed.

As previously discussed (e.g., claim 21), Semple does not teach or suggest the recited method of claim 21. Even the Action *admits* (on page 4; and via the obviousness type rejection) that Semple *alone* does not teach or suggest claim 21. Thus, the allegation that Semple discloses the computer readable instructions is without merit. The Office has not established a *prima facie* showing of obviousness.

**Claim 22 is Not Obvious Over
Semple in view of Dasan, Lawlor, and Simmons
and further in view of Jheeta**

Claim 22 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Semple in view of Dasan, Lawlor, and Simmons and further in view of Jheeta.

Claim 22 contains an obvious typographical error, as the step should be labeled (f). Permission for the Office to correct the typographical error is hereby authorized.

Claim 22

Claim 22 depends from claim 21. The references, taken alone or in combination, further do not teach or suggest displaying a promotion for a financial institution in a web page at an ATM to a customer determined not to be a customer of that financial institution. The Action admits (on page 7) that Semple/Dasan/Lawlor/Simmons do not teach or suggest features of the recited determining step.

Jheeta is directed to an ATM (14) that is operative to dispense to a customer a receipt (18) containing a promotion and a telephone number to call for redeeming the promotion. When the customer calls the telephone number, a telephonic survey (28) is conducted and includes questions (col. 3, lines 39-59) relating to products and services offered by a marketer.

The relied upon sections of Jheeta relate to a *telephone* survey, not to *displaying* a promotion for a financial institution in a *web page* at an ATM. Jheeta has a display (14a), but the messages are printed on a (paper) receipt. Furthermore, claim 22 recites that the financial institution information is determined prior to selection of a targeted advertisement (for display). The Office has not established a *prima facie* showing of obviousness.

**Claim 4 is Not Obvious Over
Semple in view of Dasan, Lawlor, and Simmons
and further in view of Akiyama**

Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Semple in view of Dasan, Lawlor, and Simmons and further in view of Akiyama.

Claim 4

Claim 4 depends from claim 2/1. The Action (on page 10) admits that Semple/Dasan/Lawlor/Simmons does not teach or suggest a data store including a smart card. The Action relies on Akiyama as teaching a smart card.

Appellants respectfully submit that the Office does not read the claim as a whole (in light of the features of claims 1 and 2). Where does Akiyama teach or suggest modifying (claim 2) a customer profile value in a data store including a smart card (claim 4), especially where the modification is responsive to an input received from an operator of the automated transaction machine?

As Akiyama cannot alleviate the deficiencies of Semple/Dasan/Lawlor/Simmons, the references, taken alone or in combination, do not teach or suggest that the recited features, relationships, and steps. The Office has not established a *prima facie* showing of obviousness.

**The Claims Are Not Obvious Over
Semple in view of Dasan, Lawlor, and Simmons
and further in view of Patterson**

Claims 6-7, 11, 17, and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Semple in view of Dasan, Lawlor, and Simmons and further in view of Patterson.

Claim 6

Claim 6 depends from claim 2/1. The Action (at pages 10-11) admits that Semple/Dasan/Lawlor/Simmons do not teach or suggest the recited features. The Action (on pages 11-12) alleges that Patterson discloses "customer profile value and customer type along with option selection." The Appellants respectfully disagree.

Nevertheless, where does Patterson teach or suggest a customer profile *value* that is *representative of a preferred* customer language? Where does Patterson teach or suggest (or even mention) different languages? The Action's assertions are not based on evidence of record. *In re Zurko*, supra. *In re Lee*, supra.

Where do the references, taken alone or in combination, teach or suggest the ability to generate a web page in a language that corresponds to a customer profile *value*? Where does Patterson relate customer profile value to the language displayed? Furthermore, where do the references, taken alone or in combination, teach or suggest the ability of a customer to change their preferred language by modifying their (customer profile) value via an input? Again, the Office has not established a *prima facie* showing of obviousness.

Claim 7

Claim 7 depends from claim 2/1. The Action (at pages 10-11) admits that Semple/Dasan/Lawlor/Simmons do not teach or suggest the recited features. The Action alleges

that Patterson discloses "customer profile value and customer type along with option selection."
The Appellants respectfully disagree.

Nevertheless, where does Patterson teach or suggest a customer profile *value* that is *representative* of a fast cash amount? Patterson teaches an ATM that predicts the type of transaction most likely to be requested by a user (col. 1, lines 21-28). However, the evidence of record does not teach or suggest that in Patterson the transaction most likely to be requested was a fast cash amount. It is also unclear how Patterson's type of *transaction* corresponds to the recited fast cash *amount*. The Office's assertion is not based on any evidence in the record and lacks substantial evidence support. Nor is the determination of patentability based on evidence of record. *In re Zurko*, supra. *In re Lee*, supra.

Further, where do the references, taken alone or in combination, teach or suggest the ability of a machine operator to modify a fast cash amount via an input. Also, where do the references, taken alone or in combination, teach or suggest the ability of a customer to change their fast cash amount by modifying their (customer profile) value via an input? Where do the references teach or suggest these features? Again, the Office has not established a *prima facie* showing of obviousness. Additionally, as Semple appears to maintain ATM transactions separate from Internet usage, it would not have been obvious to have modified Semple in the manner alleged.

Claim 11

Claim 11 depends from claim 10/9. The Action (on page 11) admits that Semple/Dasan/Lawlor/Simmons do not teach or suggest a customer profile *value* that is representative of a "last withdrawal amount." The Action (on page 7, last paragraph) alleges that

Patterson discloses "customer profile value and customer type along with option selection." The Appellants respectfully disagree.

Where does Patterson teach or suggest a customer profile value that is representative of a *last* withdrawal amount? Patterson teaches an ATM that predicts the type of transaction most likely to be requested by a user (col. 1, lines 21-28). However, the evidence of record does not teach or suggest that in Patterson the transaction most likely to be requested was the *last* withdrawal amount. It is also unclear how Patterson's type of *transaction* corresponds to the recited withdrawal *amount*. An assertion not based on any evidence in the record (which is the current situation) lacks substantial evidence support. The determination of patentability must be based on evidence of record. *In re Zurko*, supra. *In re Lee*, supra.

Further, where do the references, taken alone or in combination, teach or suggest the ability to generate a web page having a selectable option to dispense the last withdrawal amount? Where do the references teach or suggest modifying the last withdrawal amount via a selection to a web page option? Where do the references teach or suggest these features? Again, the Office has not established a *prima facie* showing of obviousness.

Claim 17

Claim 17 depends from claim 13. The Action (on page 12) admits that Semple/Dasan/Lawlor/Simmons do not teach or suggest updating a customer profile responsive to received input. That is, the Action admits that Semple/Dasan/Lawlor/Simmons do not teach or suggest recited steps (d) and (e) (contrary to the incorrect listing of the steps as (e) and (f) in the Action). An unheeded notice of this incorrect listing was also pointed out (at page 30) in the previous Appeal Brief (dated May 12, 2004).

The Action relies on "Official notice that it is old and well known in the computer art to get the advantage of providing customers with selectable options that automatically builds the customer's profile in order to present the customer with relevant selectable options upon subsequent ATM use." The Action then alleges that it would have been obvious "to include customer selectable options in which the actual selected option becomes a part of the customers' stored profile."

The Appellants respectfully disagree. The Patent Office is not permitted to rely on unsupported assertions as the basis for rejecting claims (which is the current situation), especially in final rejections. Appellants challenge the Action's relied upon "Official Notice" assertion on the basis that it is not common knowledge, well known, and supported by any reference to prior art. The evidence of record does not teach or suggest the recited features. Where does the prior art evidence of record teach or suggest updating customer profile data responsive to a received input corresponding to a selectable transaction option included in a web page displayed at an automated transaction machine? The determination of patentability must be based on concrete evidence of record. An assertion of basic knowledge and common sense (which is the current situation) not based on any evidence in the record lacks substantial evidence support. It is *never* appropriate (as in the current situation) to rely solely on "Official Notice" as the principal evidence upon which a rejection is based. *In re Zurko*, supra. *In re Lee*, supra. The rejection is based on a mere assertion (i.e., the Official notice), not evidence of record. Thus, the rejection is not legally valid.

The references of record, taken alone or in combination, do not teach or suggest updating customer profile data responsive to a received input corresponding to a selectable transaction

option included in a web page displayed at an automated transaction machine. The Office has not established a *prima facie* showing of obviousness.

Appellants note that a previous challenge to this "Official Notice" assertion was already made in the previous Appeal Brief (dated May 12, 2004). It follows that the Office has not successfully rebutted Appellants' challenge. The Action's failure to present support for the "Official Notice" assertion (especially in response to Appellants' challenge) constitutes Agency Action under the Administrative Procedures Act admitting that the relied upon "Official Notice" assertion does not have support in the prior art. Again, a *prima facie* showing of obviousness has not been established.

Claim 23

Claim 23 depends from claim 21. The Action (on page 12) admits that Semple/Dasan/Lawlor/Simmons do not teach or suggest updating a customer profile responsive to received input corresponding to a web page selection at an ATM. The Action relies on "Official notice that it is old and well known in the computer art to get the advantage of providing customers with selectable options that automatically builds the customer's profile in order to present the customer with relevant selectable options upon subsequent ATM use." The Action then alleges that it would have been obvious "to include customer selectable options in which the actual selected option becomes a part of the customers' stored profile."

The Appellants respectfully disagree. The Patent Office is not permitted to rely on unsupported assertions as the basis for rejecting claims (which is the current situation).

Appellants challenge the Action's relied upon "Official Notice" assertion on the basis that it is not supported by any reference to prior art. The evidence of record does not teach or suggest the

recited features. Where does the prior art evidence of record teach or suggest updating a customer profile responsive to a received input corresponding to a selectable option included in a targeted advertisement displayed in a web page at an ATM? The determination of patentability must be based on concrete evidence of record. An assertion of basic knowledge and common sense (which is the current situation) not based on any evidence in the record lacks substantial evidence support. It is *never* appropriate (as in the current situation) to rely solely on "Official Notice" as the principal evidence upon which a rejection is based. *In re Zurko*, supra. *In re Lee*, supra. The rejection is based on a mere assertion (i.e., the Official notice), not evidence of record. Thus, the rejection is not legally valid.

The references of record, taken alone or in combination, do not teach or suggest updating a customer profile responsive to a received input corresponding to a selectable option included in a targeted advertisement displayed in a web page at an ATM. The Office has not established a *prima facie* showing of obviousness.

The Office has not successfully rebutted Appellants' previous challenge (in the Appeal Brief dated May 12, 2004) to the "Official Notice" assertion. It follows that the Action's failure to present support for the "Official Notice" assertion (especially in response to Appellants' challenge) constitutes Agency Action under the Administrative Procedures Act admitting that the relied upon "Official Notice" assertion does not have support in the prior art. Again, a *prima facie* showing of obviousness has not been established.

**The Claims Are Not Obvious Over
Semple in view of Dasan, Lawlor, and Simmons
and further in view of Clausing**

Claims 14-15 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Semple in view of Dasan, Lawlor, and Simmons and further in view of Clausing.

Claim 14

Claim 14 depends from claim 13. The Action (on page 13) admits that Semple/Dasan/Lawlor/Simmons do not teach or suggest that a customer type value corresponds to a servicer of automated transaction machines. The Action (on page 14) alleges that Clausing discloses "option selection based on customer profile values that are associated with a specific class of service." The Appellants respectfully disagree.

Nevertheless, where does Clausing teach or suggest a customer type value corresponding to a *servicer* of automated transaction machines. Clausing is directed to having a plurality of customer stations timeshare with a local processor, where the stations are accessible to *customers*. Where does Clausing discuss a machine *servicer*?

The references, taken alone or in combination, do not teach or suggest displaying an automated transaction machine web page that includes a plurality of selectable *servicer* options for *servicing* the machine. Where do the references link machine servicer options to web page display at an automated transaction machine? Where do the references even mention a *servicer* of an automated transaction machine? The rejection is based on a mere assertion, not evidence of record. *In re Zurko*, supra. *In re Lee*, supra.

The Office has not established a *prima facie* showing of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified

Semple/Dasan/Lawlor/Simmons with the alleged teaching of Clausing to have produced the recited method.

Claim 15

The Action (on page 14, first paragraph) admits that Semple/Dasan/Lawlor/Simmons do not teach or suggest that a "customer type value corresponds to a consumer." The Action further admits that these references do not teach or suggest a web page "including a plurality of selectable transaction options for performing transactions with the automated transaction machine."

The Action is silent as to where Clausing teaches or suggests the recited features. Regardless, the references, taken alone or in combination, do not teach or suggest displaying a web page that includes a plurality of selectable transaction options for performing transactions with the automated transaction machine when the customer type corresponds to a consumer. It would not have been obvious to one having ordinary skill in the art to have modified Semple/Dasan/Lawlor/Simmons in the manner alleged to have produced the recited method.

Claim 18

Claim 18 depends from claim 13. The Action (on page 14, second paragraph) admits that Semple/Dasan/Lawlor/Simmons does not teach or suggest the recited features of claim 18. The Action (at page 14, last paragraph) alleges obviousness based on the teaching of Clausing. However, Clausing does not teach or suggest that when a *customer type* value corresponds to a first *class of customer*, the displayed web page includes a first option to perform a first transaction with the automated transaction machine, and when the *customer type* value corresponds to a second *class of customer*, the displayed web page does not include the first

option. Where does Clausing (especially in the relied upon sections) or any of the references, taken alone or in combination, teach or suggest the ability to display a web page with a first transaction option to a first class of customer and not display the first transaction option in a web page to a second class of customer?

The references do not teach or suggest the recited method. It follows that it would not have been obvious to one having ordinary skill in the art to have modified Semple/Dasan/Lawlor/Simmons in the manner alleged to have produced the recited method.

**Claim 16 is Not Obvious Over
Semple in view of Dasan, Lawlor, Simmons, and Clausing
and further in view of Patterson**

Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Semple in view of Dasan, Lawlor, Simmons, and Clausing and further in view of Patterson.

Claim 16

Claim 16 depends from claim 15/13. The Action does not address the *recited* features of claim 16. The Action (on page 15) refers to steps (e) and (f). However, recited claim 16 recites steps (d) and (e), without a step (f). The Action is silent regarding the recited step of dispensing an amount of cash with a cash dispenser device responsive to the input (in step d). This issue was previously brought to the attention of the Office numerous times, including in the Appellants' Appeal Brief (on page 27) filed November 14, 2003 and the Appeal Brief (on page 30) filed May 12, 2004. The failure of the Office to correct the issue gives the appearance that Appellants' arguments against the rejection were never considered.

The references, taken alone or in combination, do not teach or suggest dispensing an amount of cash with a cash dispenser device responsive to receiving an input that corresponds to a selectable transaction option displayed on a web page at an automated transaction machine. The Action admits that Semple/Dasan/Lawlor/Simmons/Clausing do not teach or suggest the recited features of claim 16. As Patterson has not been shown by the Office to teach or suggest the recited features, a *prima facie* showing of obviousness has not been established. Further, Patterson cannot alleviate the admitted deficiencies of Semple/Dasan/Lawlor/Simmons/Clausing as it does not teach or suggest the recited features which are not found therein. The mention of "Official Notice" is bewildering, as it is not pertinent to the recited claim language. Nonetheless, the "Official Notice" assertion is challenged by Appellants.

**Claim 19 is Not Obvious Over
Semple in view of Dasan, Lawlor, Simmons, and Clausing
and further in view of Martin**

Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Semple in view of Dasan, Lawlor, Simmons, and Clausing and further in view of Martin.

Claim 19

Claim 19 depends from claim 18/13. The Action (on page 16, last paragraph) admits that Semple/Dasan/Lawlor/Simmons/Clausing do not teach or suggest that the first transaction corresponds to bill payment. The Action relies on Martin as teaching ATM transactions that permit bill payment. The Action then alleges that it would have been obvious to have modified Semple/Dasan/Lawlor/Simmons/Clausing to have included using an ATM screen to select bill payment.

The Appellants respectfully disagree. Martin does not teach or suggest that when a customer type value corresponds to a first class of customer (claim 18), a displayed web page includes an option to pay a bill (claim 19) with the automated transaction machine, and when the customer type value corresponds to a second class of customer (claim 18), the displayed web page does not include the bill pay option. Where does Martin teach or suggest displaying a web page? Where do the references, taken alone or in combination, teach or suggest the ability to display a web page with a bill payment option to a first class of customer and display a web page without the bill payment option to a second class of customer?

The Office has not established a *prima facie* showing of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified Semple/Dasan/Lawlor/Simmons/Clausing in the manner alleged to have produced the recited method.

CONCLUSION

Each of Appellants' pending claims specifically recites features and relationships that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any teaching, suggestion, or motivation for combining features of the applied prior art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



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(viii)

CLAIMS APPENDIX

1. A method of operating an automated transaction machine comprising:
 - a) reading customer identification information from a card with a card reading device in operative connection with an automated transaction machine;
 - b) accessing at least one customer profile value from at least one data store, responsive to the customer identification information;
 - c) generating at least one web page responsive to the at least one customer profile value; and
 - d) displaying the at least one web page at the machine through operation of a browser, wherein the at least one web page includes a plurality of selectable transaction options for performing transactions with the automated transaction machine.
2. The method according to claim 1, further comprising:
 - e) receiving an input from an operator of the automated transaction machine; and
 - f) modifying the at least one customer profile value in the data store responsive to the input.

3. The method according to claim 2, wherein the data store includes a remote database.
4. The method according to claim 2, wherein the data store includes a smart card.
5. The method according to claim 1, wherein in step (a) the reading device includes a smart card reader device, and wherein the customer identification information is read from a smart card.
6. The method according to claim 2, wherein the customer profile value is representative of the preferred natural language of the customer, wherein the web page is generated in a language that corresponds to the value, wherein the input is representative of a different value for the preferred natural language of the customer.
7. The method according to claim 2, wherein the customer profile value is representative of a fast cash amount, wherein the web page includes a selectable option which corresponds to having the automated transaction machine dispense an amount of cash that is equal to the fast cash amount, wherein step (f) includes modifying the fast cash amount.
8. Computer readable media having computer readable instructions embodied thereon, the computer readable instructions operative to cause at least one computer to carry out the method steps recited in claim 1.

9. A method comprising:

- a) reading an account number from a card with a card reading device of an automated transaction machine;
- b) accessing a plurality of customer profile values that correspond to the account number;
- c) displaying a web page in a browser with the automated transaction machine, wherein the web page includes a plurality of selectable options for performing a transaction with the automated transaction machine, wherein at least one of the selectable options is produced responsive to at least one of the accessed customer profile values;
- d) receiving an input that corresponds to a selected one of the selectable options with an input device; and
- e) performing the transaction with the automated transaction machine responsive to the selected one of the selectable options.

10. The method according to claim 9, further comprising:
 - f) modifying at least one of the accessed customer profile values in the data store responsive to the selected option.
11. The method according to claim 10, wherein the customer profile values include a last withdrawal amount representative of a previously withdrawn amount of cash, wherein one of the selectable options corresponds to a dispensing of an amount of cash equal to the last withdrawal amount, wherein step (e) includes dispensing of a selected amount of cash with a cash dispenser device, and wherein step (f) includes modifying the last withdrawal amount with a value that corresponds to the selected amount of cash.
12. Computer readable media having computer readable instructions embodied thereon, the computer readable instructions operative to cause at least one computer to carry out the method steps recited in claim 9.

13. A method comprising:
- a) receiving at least one customer identification value with an automated transaction machine;
 - b) accessing a customer profile from a data store, wherein the customer profile corresponds to the customer identification value, wherein the customer profile includes a customer type value, wherein a customer type value differentiates between classes of customers with regard to operations available with the automated transaction machine; and
 - c) displaying a web page in a browser of the automated transaction machine, wherein the web page is loaded responsive to the customer type value.
14. The method according to claim 13, wherein when the customer type value corresponds to a servicer of automated transaction machines, the web page includes a plurality of selectable servicer options for servicing the automated transaction machine.
15. The method according to claim 13, wherein when the customer type value corresponds to a consumer, the web page includes a plurality of selectable transaction options for performing transactions with the automated transaction machine.

16. The method according to claim 15, further comprising:

- d) receiving an input that corresponds to one of the selectable transaction options;
and
- e) dispensing an amount of cash with a cash dispenser device responsive to the input.

17. The method according to claim 13, wherein the web page includes a plurality of selectable transaction options for performing transactions with the automated transaction machine, and wherein the method further comprises:

- d) receiving an input that corresponds to one of the selectable transaction options;
and
- e) updating the customer profile data responsive to the input.

18. The method according to claim 13

wherein when the customer type value corresponds to a first class of customer, the web page includes a first option to perform a first transaction with the automated transaction machine,

wherein when the customer type corresponds to a second class of customer, the web page does not include the first option.

19. The method according to claim 18, wherein the first transaction corresponds to bill payment.
20. Computer readable media having computer readable instructions embodied thereon, the computer readable instructions operative to cause at least one computer to carry out the method steps recited in claim 13.
21. A method comprising:
 - a) receiving a customer identity information at an ATM, wherein the ATM includes a cash dispenser operative to dispense cash;
 - b) accessing a customer profile responsive to the customer identity information;
 - c) retrieving marketing information from the customer profile;
 - d) selecting a targeted advertisement responsive to the marketing information; and
 - e) displaying a web page in a browser of the ATM, wherein the web page includes the targeted advertisement.

22. The method according to claim 21, further comprising prior to step (d):
- e) determining if the consumer is a customer associated with a financial institution, wherein if the consumer is determined not to be a customer of the financial institution, the targeted advertisement includes a promotion for the financial institution.
23. The method according to claim 21, wherein the targeted advertisement includes at least one selectable option, wherein the method further comprises:
- (f) receiving an input from the consumer that corresponds to the selectable option; and
 - (g) updating the customer profile responsive to the input.
24. Computer readable media having computer readable instructions embodied thereon, the computer readable instructions operative to cause at least one computer to carry out the method steps recited in claim 21.

25. A method comprising:

- (a) receiving customer identification information with an ATM, wherein the ATM includes at least one banking transaction function device, wherein the at least one banking transaction function device includes a currency dispenser operative to dispense currency,
- (b) displaying at least one web page at the ATM through operation of at least one browser, wherein the at least one web page respectively corresponds to the received customer identification information, wherein the at least one web page includes a plurality of banking transaction selections associated with performing banking transactions with the ATM, and wherein at least one of the selections includes a currency withdrawal request.

26. The method according to claim 25 and further comprising:

- (c) receiving an input corresponding to a selection with the at least one input device of the ATM,
- (d) responsive to step (c), accessing at least one markup language document from at least one data store, wherein the at least one markup language document includes at least one instruction adapted to cause operation of at least one banking transaction function device associated with carrying out a banking transaction function corresponding to the selection,
- (e) responsive to the at least one instruction accessed in step (d), operating the at least one banking transaction function device in carrying out the banking transaction function.

27. The method according to claim 26 wherein step (a) includes reading customer identification information with a reading device in operative connection with the ATM, and further comprising:
- (f) responsive to the customer identification information read in step (a), accessing at least one customer profile from at least one data store,
 - (g) generating at least one web page responsive to the at least one customer profile,
- wherein step (b) includes displaying the at least one web page generated in step (g).
28. The method according to claim 27 wherein in step (d) the at least one markup document is accessed via the Internet and includes a currency dispense instruction operative to cause operation of the currency dispenser,
- wherein step (e) includes operating the currency dispenser to dispense currency responsive to the currency dispense instruction.

(ix)

EVIDENCE APPENDIX

(None)

(x)

RELATED PROCEEDINGS APPENDIX

(None)